

**Remarks**

Applicants respectfully traverses the rejection of claims 1 – 3, 7 – 10, 12 – 17, and 28 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

The Examiner states that Figures 1a, 1b, 2b, 2c, 2d and page 18 of the specification do not teach geometrically symmetrically shaped particles suitable for the purpose of practicing Applicants' claimed invention.

Applicants respectfully submit that the Examiner's conclusion ignores the facts of Applicants explicit disclosure.

Fig. 1a is a schematic illustration of a porous woven material having a layer of symmetrical shaped friction modifying material at least partially covering the surface of the porous woven material.

Fig. 1b is a schematic illustration of a porous woven material having a layer of symmetrical shaped friction modifying material fully covering the surface of the porous woven material.

Fig. 2b is a scanning electron microphotograph showing a porous woven material partially coated with symmetrically shaped friction modifying particles.

Fig. 2c is a scanning electron microphotograph showing a porous woven material partially coated with symmetrically shaped friction modifying particles.

Fig. 2d is a scanning electron microphotograph showing a porous woven material coated with symmetrically shaped friction modifying particles.

Page 18 of the specification and the following Examples further enable the claims.

The useful friction modifying particles comprise a mixture of the geometrically symmetrically shaped friction modifying particles and at least one type of irregularly shaped friction modifying particles such as silica particles; resin powders such as phenolic resins, silicone resins epoxy resins and mixtures thereof; partial and/or fully carbonized carbon powders and/or particles admixtures thereof; and mixtures of such friction modifying particles. In particular, silica particles such as diatomaceous earth, Celite®, Celatom®, and/or silicon dioxide are especially useful. The silica particles are inexpensive organic materials which bond strongly to the fibrous materials. The silica particles provide high coefficients of friction to the friction material. The silica particles also provide the friction material with a smooth friction surface and provides a good “shift feel” and friction characteristics to the friction material such that any “shudder” is minimized.

Applicants specification clearly is enabling for the claimed particles.

The Examiner also states that the specification does not disclose a process to make the claimed geometrically symmetrically shaped friction modifying particles.

Applicants respectfully submit that the Examiner is adding to the enablement requirement what is not required.

Applicants respectfully submit that this statement has no support in fact, theory or law.

The purpose of the claims and specification is not to explain the technology or how it works, but to state the legal boundaries of the patent grant. Applicants' claims and specification do this.

The patent claims and specification satisfy the statutory requirement as follows: If one skilled in the art would understand the bounds of the claims when read in light of the specification, then the claim satisfies section 112.

Applicants' claims and specification do this.

Section 112 requires that an inventor adequately set forth and describe, the manner and process of making and using the invention (the enablement requirement). To fulfill the enablement requirement, an applicant need not describe actual embodiments or examples. Nevertheless, the presence or absence of examples in a patent application is a factor in determining the extent to which claims, particularly broad claims involving an unpredictable technology, are enabled. What is important is that a person of ordinary skill in the art is able to practice the invention without undue experimentation. Johns Hopkins University v. Cellpro, Inc. 152 F.3d 1342, 1354 (Fed.Cir. 1998).

Accordingly, Applicants respectfully ask that the Examiner withdraw this rejection.

Applicants respectfully traverse the rejection of claims 1 – 3, 7 – 10, 12 – 17 and 28 under 35 U.S.C. §102(b) or, in the alternative, under 35 U.S.C. §103(a) over EP 1203897 to Lam.

Claims 1 – 3, 7 – 10, 12 – 17 and 28 patentably distinguish over Lam in the recitation of wherein the secondary layer comprises about 20% to about 35%, by weight, of symmetrically shaped silica particles, or about 65% to about 80%, by weight, carbon particles, based on the total weight of the friction modifying particle.

Nowhere does Lam disclose or suggest this.

The Examiner then states that the shape limitation is deemed to be inherent to the friction modifying particles.

Applicants respectfully submit that no basis in fact or theory exists to support this statement.

The Federal Court has set forth a standard for inherency. The holding of the CAFC is that one of ordinary skill in the art is not required to recognize an inherent feature in a prior art disclosure, Schering Corp. v. Geneva Pharmaceuticals, Inc., 339 F.3d 1373 (Fed.Cir. 2003). The inherency must be “necessarily present” and not merely sometimes, occasionally, or possible present. The examiner must supply a rationale for the inherent disclosure or evidence

demonstrating the presence of inherency. Inherency is a factual issue, and as part of an invalidity determination, must be proven by clean and convincing evidence.

Applicants respectfully submit that the Examiner has failed to establish any basis to support his conclusion of inherency.

Nowhere does Lam disclose the combination of symmetrically shaped silica particles and carbon particles.

Nowhere does lam disclose or suggest that the secondary layer comprises 20% to 35%, by weight, of symmetrically shaped silica particles, based on the total weight of the friction modifying particles.

Nowhere does Lam disclose or suggest that the secondary layer comprises 65% to 80%, by weight, carbon particles, based on the total weight of the friction modifying particles.

The Federal Court has set out the standard for anticipation rejections under section 102:

A determination that a claim is invalid as being anticipated or lacking novelty under 35 U.S.C. §102 requires a finding that "each and every limitations is found either expressly in a single prior art reference." Oakley, Inc. v. Sunglass Hut Int'l, 316 F.3d 1331, 1339, 65 USPQ2d 1321, 1325 (Fed.Cir. 2003)(citation omitted).

Every element of the claimed invention must be literally present arranged as in the claims". Richardson v. Suzuki Motor Co., 868 F2d 1226, 1236, 9 USPQ2d

1913, 1920 (Fed.Cir. 1989).

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person having ordinary skill in the art.

Scripps Clinic & Research Foundation v. Genentech, Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed.Cir. 1991).

To establish a *prima facie* case of obviousness, the Examiner must, *inter alia*, show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.: In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2006 (Fed.Cir. 2002). "When the references cited by the examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned." In re Brouwer, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed.Cir. 1996).

Of utmost importance is the reliance upon facts and not conclusory assertions to establish obviousness. Assumptions about knowledge in the art cannot substitute for evidence thereof.

Applicants respectfully submit that their specification is the only source of support for the claimed arrangement of method steps or programmed system.

Clearly, Lam does not disclose that the geometrically symmetrically shaped silica friction modifying particles have a substantially flat disc shape.

The Examiner then states that the shape limitation is deemed to be inherent to the friction modifying particles.

Applicants respectfully submit that no basis in fact or theory exists to support this statement.

The Federal Court has set forth a standard for inherency. The holding of the CAFC is that one of ordinary skill in the art is not required to recognize an inherent feature in a prior art disclosure, Schering Corp. v. Geneva Pharmaceuticals, Inc., 339 F.3d 1373 (Fed.Cir. 2003). The inherency must be “necessarily present” and not merely sometimes, occasionally, or possible present. The examiner must supply a rationale for the inherent disclosure or evidence demonstrating the presence of the inherency. Inherency is a factual issue and, as part of an invalidity determination, must be proven by clean and convincing evidence.

Applicants respectfully submit that the Examiner has failed to establish any basis to support his conclusion of inherency.

Nowhere does Lam disclose the combination of symmetrically shaped silica particles and carbon particles.

Not only has the Examiner failed to make out a case of anticipation, but the Examiner also has failed to establish a case of *prima facie* obviousness.

Applicants respectfully submit that no basis in fact or theory exists to

support the Examiner's rejection. Lam is deficient.

The Examiner's position attempts to add to Lam what is not there.

Therefore, Applicants respectfully submit that claims 1 – 3, 7 – 10, 12 – 17 and 28 as amended are in condition for allowance and respectfully ask that the Examiner pass the claims to issue.

Respectfully submitted,

EMCH, SCHAFFER, SCHAUB  
& PORCELLO CO., L.P.A.

A handwritten signature in black ink, appearing to read 'P. Pacella', written in a cursive style.

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